

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Michael P. Cooke

Application No.: 10/777,028

Filed: February 11, 2004

For: Methods and Compositions for
Modulating Stem Cells

Examiner: Celine X. Qian, Ph.D.

Art Unit: 1636

Confirmation No.: 2201

Response to Restriction Requirement

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

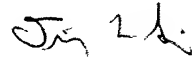
This is submitted in response to the Office Action dated August 9, 2006 which sets forth a restriction requirement in the above-captioned patent application. In response, Applicant elects, with traverse, the claims of Group I (i.e., Claims 1-7 and 15-18).

The Office Action also requires that Applicants select one gene or combination of genes or polypeptides from tables 1-4 for examination. Applicants hereby elect GATA3 (human GATA-binding protein 3) for substantive examination in the subject patent application.

This election is made with traverse, as the restriction requirement improperly splits a single claim into multiple groups. Such a restriction requirement is improper as a matter of law. The courts have long held that the section of the patent statute that authorizes restriction practice, *i.e.*, 35 U.S.C. 121, provides no legal authority to impose a rejection on a single claim, even if the claim presents multiple independently patentable inventions. *See, In re Weber*, 198 USPQ 328, 331 (CCPA 1978); *In re Haas*, 179 USPQ 623, 624-625 (*In re Haas I*) (CCPA 1973) and *In re Haas* 198 USPQ 334-337 (*In re Haas II*) (CCPA 1978).

If a telephone conference would expedite prosecution of this application, please telephone the undersigned attorney at 858-812-1547.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Tim L. Smith".

Timothy L. Smith, Ph.D.
Reg. No. 35,367

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